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Paper No. 7

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OFFICE OF PETITIONS

In re Patent No. 6,185,764	:	
Issued: February 13, 2001	:	ON PETITION
Application No. 09/332,394	:	
Filed: June 14, 1999	:	
Title: MOTORIZED FOLDING BED	:	

This is in response to the petition under 37 CFR 1.378(b), filed January 23, 2012, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued February 13, 2001. The second maintenance fee could have been paid during the period from February 13, 2008 through August 13, 2008 or with a surcharge during the period from August 14, 2008 through February 13, 2009. Accordingly, this patent expired on February 14, 2009, for failure to timely remit the maintenance fee due at 7.5 years.

Petitioner asserted that the delay in paying the maintenance fee was unavoidable because of financial difficulties. Specifically, petitioner explained that in the last part of 2007 and early 2008, due to a lack of customer, low sales, and financial loss, he had to close his retail business. Petitioner indicated that he was deeply in debt and at age 83 could not find any firm to hire him. Petitioner stated that in 2010, he obtained a means to create a small amount of income. Petitioner explained that he had been living on social security and the kindness of his ex-wife. Petitioner indicated that he saved a portion of the

fees and borrowed the balance to pay the maintenance fees due at 7.5 years. Petitioner asserted that he contacted a major firm, which is preparing plans to start producing the invention in quantity and agreed to pay petitioner a small royalty per unit.

The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable and if the surcharge required by 37 CFR 1.20(i) is paid as a condition of accepting payment of the maintenance fee. 37 CFR 1.378(a).

A grantable petition under 37 CFR 1.378(b) to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (1) the required maintenance fee set forth in 37 CFR 1.20(e) through (g);
- (2) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

This petition lacks requirement (3) above.

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912)

(quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). MPEP 2590(I). An adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps that were taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b). Id.

To meet the showing of unavoidable delay based upon financial hardship, petitioner must establish that the financial condition of the patent owner during the entire period of the delay was such as to excuse the delay. See Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). A complete showing, with supporting documentation, is required of the financial condition of the party who was responsible for payment of the maintenance fee. Therefore, petitioner must provide a MONTHLY breakdown of all his income, expenses, assets, credit, and obligations during the entire period from February 13, 2009, until the present, which made the delay in payment of the maintenance fee "unavoidable." Petitioner should provide copies of any documents or records such as bank statements and tax returns that would confirm the financial difficulty. In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, he was financially unable to make the payment until the petition was filed. The Office strongly advises petitioner to avoid submitting personal information such as social security numbers, bank account numbers, or credit card numbers in any documents submitted with a petition for reconsideration under 37 CFR 1.378(e). Petitioner is further advised that the record of a patent application is available to the public after issuance of a patent.

Petitioner indicated that he had contacted a major firm, which is preparing plans to start production of the invention in quantity and agreed to pay him a small royalty per unit. The Office reminds petitioner that a failure to pay the maintenance fee and enforce the patent due to a belief that the patent is not of sufficient financial value to justify the expense or until the industry shows an interest in the invention is the antithesis of an "unavoidable" or "unintentional" delay and would preclude a finding of unavoidable or unintentional delay. See In re Maldague, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988); MPEP 711.03(c)(II)(D). Therefore, petitioner must demonstrate that he did not make a deliberate

choice to delay payment of the maintenance fee and enforcement of the patent based upon whether the firm was interested in manufacturing the invention and paying him a royalty.

In summary, the showing of record is inadequate to establish unavoidable delay. Petitioner has not provided sufficient documentary evidence to substantiate a claim of unavoidable delay. Accordingly, the petition is **dismissed**.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking further reconsideration is not refundable. Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

The Office notes that the address indicated on the petition differs from the address of record. As a one-time courtesy the Office will mail this communication to the address listed in the petition. However, if petitioner wishes to receive future correspondence concerning this patent, petitioner should submit a change of correspondence address. The appropriate form (Form PTO/SB/123) accompanies this decision for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Services Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

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Telephone inquiries should be directed to the undersigned at 571-272-3211.

/Christina Tartera Donnell/

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